

REMARKS

This Amendment is submitted in response to the Office Action dated August 4, 2003. In the Office Action, the Patent Office rejected Claims 1-3, 7-9 and 11 under 35 U.S.C. §102(b) as being anticipated by *Fabel* (U.S. Patent No. 5,836,622). Additionally, the Patent Office rejected Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725) in view of *Schwan et al.* (U.S. Patent No. 5,524,934). Further, the Patent Office rejected Claims 4 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Petkovsek* (U.S. Patent No. 5,697,648). Applicant notes with appreciation that the Patent Office indicated that Claims 13-23 are in allowable form.

Applicant further notes with appreciation that the Patent Office indicated that Claims 5, 6 and 10 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. To this end, Applicant added Claim 24 incorporating Claim 5 with Claim 1; Applicant added Claim 25 incorporating Claim 6 with Claim 1; and Applicant added Claim 26 incorporating Claim 10 with Claim 9. Applicant submits that new Claims 24-26 are, therefore, in allowable form.

By the present amendment, Applicant amended the specification, Claims 1 and 9 and added Claims 24-26. Applicant corrected the specification to reflect the status of the parent applications of

the present invention. Applicant submits that the amendments to the claims overcome the rejections made by the Patent Office and places the application in condition for allowance. Notice to that effect is respectfully requested.

With respect to the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C §102(b) as being anticipated by *Fabel*, Applicant submits that the rejection has been overcome in view of the foregoing amendments and the remarks that follow.

In the Office Action, the Patent Office alleges that:

Fabel discloses in Fig. 13, a mailing assembly and a method of preparing a mail piece comprising: a label (72) having a front side (74) and a backside (75); and further wherein the label (72) includes shading and printing, wherein the shading and printing on the label are a single color (Col. 9, lines 26-33, wherein the information indicia is "printed in a green color"; and in Col. 10, lines 20-26, wherein the return receipt has a background color "using the same green ink used to pre-print information on sender's receipt section").

However, independent Claim 1, as amended, requires a special service mailing assembly having a label which has a front side and a backside. Additionally, Claim 1 requires the label to have a designator section indicative of a special service which is contained completely within exterior sides that define the return postcard. Moreover, Claim 1 requires the front side and the backside of the label to include shading and printing which are a single color.

Independent Claim 9, as amended, requires a method for preparing a mailpiece for delivery by a special service having

the step of providing a label which has a front side and a back side. Further, Claim 9 requires the label to have a designator section which is contained completely within exterior sides that define the return postcard. Moreover, Claim 9 requires that the front side of the label includes shading and printing which are a single color and the backside includes indicia.

Fabel merely teaches a single form which provides various elements required for sending certified mail. As shown in Figure 13, *Fabel* teaches that the block 158 is located on the upper section 146 of the return receipt 86. Further, *Fabel* teaches that "the sender's address and the POSTNET code representing the ZIP code within the sender's address are printed in appropriate locations on lower section 144." (See *Fabel*, column 10, lines 51-54.) Moreover, *Fabel* teaches that the return receipt 86 is "divided into a lower section 144 and an upper section 146 by a fold line 148." (See *Fabel*, column 10, lines 15-18.)

Nowhere does *Fabel* teach or suggest a special service mailing assembly having a label having a front side and a back side wherein the front side and the back side of the label include shading and printing which are a single color as required by Claim 1. *Fabel* merely teaches that the "front sheet 74 is preferably white, with pre-printed information on

sender's receipt section 84 being printed in a green color used by the U.S. Postal Service to signify such documents associated with certified mail." (See *Fabel*, column 9, lines 30-33.) *Fabel* does not teach a label having a front side and a back side wherein the front side and back side include shading and printing which are a single color as required by Claim 1.

Nowhere does *Fabel* teach or suggest a method for preparing a mailpiece for delivery by a special service having a label with a front side including shading and printing which are a single color and a back side including indicia as required by Claim 9. *Fabel* merely teaches that "the interior surface of back sheet 75, release materials 77, such as silicone release coatings, are placed over panels 98 and 100, which underlie label areas 90 and 92, respectively." (See *Fabel*, column 8, lines 47-50) Further, *Fabel* teaches that the "back sheet 75 also includes a transverse tear line 102 underlying transverse tear line 87 of front sheet 74, and a fold line 104 underlying fold line 96 of front sheet 74." (See *Fabel*, column 8, lines 53-56) *Fabel* does not teach a label with the front side of the label including shading and printing which are a single color and the back side including indicia as required by Claim 9.

Under 35 U.S.C. §102(b), anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986).

Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial", and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Since *Fabel* fails to disclose a label having a front side and a back side including shading and printing which are a single color and a front side including the shading and the printing with the backside including indicia as required by Claims 1 and 9, respectively, the rejection under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.*, Applicant submits that this rejection is improper for the reasons that follow. The Patent Office alleges:

Walz discloses in Fig. 1, 4 and 5, a mailing assembly comprising a label having a front side and a

backside wherein the label includes a postcard and an integrally formed designator section.

However, the Patent Office admits that "Walz does not disclose: a designator section indicative of a special service and has a machine readable code; and a label including shading and printing wherein the shading and printing are a single color."

Additionally, the Patent Office alleges:

Schwan et al. discloses in Fig. 2, 3 and 5, a record in the form of a label assembly (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors, wherein coatings of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible areas (Fig. 3 and Fig. 4). The coatings (color formers and color developers) can be applied in selection areas on the label, and when combined can form blocks of background color(s) or may be applied so as to form symbols or indicia (Col. 4, lines 58-61 and Claims 1-3), both in many different shades or hues (Col. 4, lines 14-20.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Walz's* label to include a label having self contained coatings to form a shading and printing of a particular color as set forth by *Schwan et al.* for the purpose of providing an advantage that both information and colored areas on a document can be achieved by printing in a single pass through a thermal or impact printer and further wherein the colored label can be used as an indication of where the label and its accompanying contents are to be routed.

As set forth above, independent Claims 1 and 9, as amended, requires a label which has a front side and a

backside. Claim 1 requires the front side and the backside of the label to include shading and printing which are a single color. Claim 9 requires the front side of the label to include shading and printing which are a single color and the backside to include indicia.

Walz merely discloses a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and sections of the sheets are separable from one another. Contrary to the assertions of the Patent Office, *Schwan et al.* merely teach a sheet containing surface coatings of selected color formers and color developers which, when subjected to heat or pressure, combine to form different colored areas on the sheet. Further, *Schwan et al.* merely teach that "the coating may be applied in selected areas which can form blocks of background color, or they may be applied so as to form images, symbols, stripes, borders, and the like." (See *Schwan et al.*, column 4, lines 57-60.) Still further, *Schwan et al.* teach that "both the colored areas and printed information on the record can be formed in a single printing pass." (See *Schwan et al.*, column 6, lines 2-4.)

Neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label wherein the front side and the back side include shading and printing which are a

single color as required by Claim 1. Additionally, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label wherein a front side includes shading and printing which are a single color and a backside includes indicia as required by Claim 9. The Patent Office admits that *Walz* does not disclose a label including shading and printing wherein the shading and printing are a single color. *Schwan et al.* merely teach that "the invention has the advantage that both information and the colored areas on the document may be achieved by printing in a single pass through a thermal or impact printer." (See *Schwan et al.*, column 7, lines 7-10.) Nowhere does *Schwan et al.* teach or suggest a form having a back side which includes information and colored areas wherein the information and colored areas are a single color and a backside which includes indicia as required by Claims 1 and 9, respectively.

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Walz* with *Schwan et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Walz* and *Schwan et al.* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Walz* with *Schwan et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the

Patent Office, the references still lack the novel features and structural relationships and the novel steps positively recited in Claims 1 and 9, respectively. Namely, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label having a backside which includes shading and printing which are a single color and a backside which includes indicia as required by Claims 1 and 9, respectively. Accordingly, the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

The Patent Office further rejected Claims 4 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and in further view of *Petkovsek*. Dependent Claim 4 requires a special service mailing assembly having a printer track strip associated with the label extending outside one of the exterior sides of the return postcard wherein the printer track strip includes a hole. Dependent Claim 12 requires a method for preparing a mailpiece for delivery by a special service having the step of providing a printer tracking strip removably attached to the anchor portion. The Patent Office alleges that *Petkovsek* discloses a mailing assembly having a backing sheet (11) with a printer track strip (56) with holes (54) extending outside the exterior sides of the postcard (18) and is removably attached

to the anchor portion (28). However, *Petkovsek* merely teaches an assembly which includes a single sheet constructed in such a way that one portion of the sheet provides a label and the other portion provides a return postcard or other special service form for attachment to an envelope in its assembled position. Applicant submits that *Petkovsek* does not teach or suggest that which is not taught by *Walz* and/or *Schwan et al.* as set forth above. Namely, *Petkovsek* does not teach or suggest a label having a back side including shading and printing which are a single color and a backside including indicia as required by Claims 1 and 9, respectively. Further, *Petkovsek* does not teach or suggest a label having a designator section indicative of a special service which is contained completely within exterior sides that define the return postcard as required by Claims 1 and 9. Moreover, no reason or suggestion exists in *Petkovsek*, *Walz* and/or *Schwan et al.* to combine *Petkovsek* with either or both of those references. Accordingly, a *prima facie* case of obviousness has not been established as required under 35 U.S.C. §103. Therefore, the rejection of Claims 4 and 12 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Claims 2-8 depend from Claim 1; and Claims 10-12 depend from Claim 9. These claims are further believed allowable

over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and novel steps of Applicant's novel assembly and method for preparing mailpieces, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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